

**REMARKS**

Claims 1-6, 9-12, 19, and 22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hall. Claims 1-7, 9-13, 19, 20, and 22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Santicola. Claims 1, 8-9, 15-17, and 23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hartwig. Claims 1-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Davidson in view of Hall.

**Non-Analogous Art**

Independent claims 1, 10, 15 and 19 have been amended in the preamble to clarify that the invention is directed towards a "food blender", similar to the preamble of claim 23. The Hall patent, cited against independent claims 1, 10 and 19 is non-analogous art, and should be withdrawn as a reference. More particularly, the test for non-analogous art is (1) whether the reference is within the field of the inventor's endeavor, and if not, (2) whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. Under the first prong, the Hall wine aerator is not in the same field of endeavor as Applicant's food blender. Under the second prong, as described in the Background of the Invention, the particular problem addressed by the present invention is mixing of food products which have cavitation problems in prior art blender jars. The Hall wine aerator clearly does not have cavitation problems, since wine is a liquid. Thus, Hall is not pertinent to the problem addressed by the present invention.

Since the Hall fails both prongs of the non-analogous art test, the rejections based upon Hall should be withdrawn.

Similarly, Santicola is non-analogous art. Santicola is directed towards a salad dressing container, which does not constitute a food blender. Therefore, Santicola fails the first prong of

the non-analogous art test. Under the second prong, salad dressing is a liquid which does not have a cavitation problem, as such that Santicola fails the second prong of the non-analogous art test. Accordingly, Santicola should be withdrawn as a prior art reference and the rejections based upon Santicola should be withdrawn.

### Anticipation Rejections

For a § 102 rejection, a single reference "must disclose each and every element of a claimed invention." Tate Engineering, Inc. v. United States, 477 F.2d 1336, 1342 (Ct. Cl. 1973). Furthermore, each element of the claim and cited reference "must function in substantially the same way to produce substantially the same result." Id. The rejection under 35 U.S.C. § 102 is only proper "when the claimed subject matter is identically disclosed or described in the prior art." Application of Marshall, 579 F.2d 301, 304 (CCPA 1978). Prior art that is only "substantially the same as the claimed invention" likewise cannot show anticipation. Jamesbury Corp. vs. Litton Industries Products, Inc., 756 F.2d 1556, 1560 (Fed. Cir. 1995).

Applying these legal standards, it is virtually impossible for a product that is not the same type of product as the claimed invention to legally anticipate the invention. As explained by the Federal Circuit, "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." Scripps Clinic & Research Foundation vs. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir 1991), (*emphasis added*). "Any degree of physical difference between the patented product and the prior art, no matter how slight, defeats the claim of anticipation." American Permahedge, Inc. v. Barcana, Inc., 857 F.Supp. 307, 317 (SDNY 1994), *affirmed*, 105 F.3d 1441 (Fed. Cir. 1997).

For anticipation, every element must be present in the prior art reference, "arranged as in the claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236 (Fed. Cir. 1989). The identical invention must be shown in its complete detail as contained in the claim. Id.

Therefore, unless a prior art reference is both functionally and physically identical to the claimed invention, it cannot anticipate the claimed invention.

Each of the independent claims 1, 10, 15, 19 and 23 are directed towards a food blender. Since Hall and Santicola mix liquids, and do not blend food, Hall and Santicola do not anticipate the claims.

Each of the independent claims also require an electric motor and knives. Hall does not have knives, and Santicola does not have an electric motor. Therefore, Hall and Santicola do not anticipate any of the claims.

Claim 1 has been amended to require a food blender with "a substantially symmetrical body" having a cross sectional area "progressing upwardly from narrow to wide to narrow to enhance blending action in the jar". As described in the Specification, this jar shape enhances blending action and eliminates cavitation. See page 3, lines 26-29. The Santicola and Hartwig patents do not disclose this shape for a food blender jar. Santicola is not symmetrical. Hartwig does not change the cross section as described in claim 1.

Therefore, claim 1 distinguishes over these references so as to be in proper form for allowance. Claims 2-9 depend from claim 1 and should be allowable as depending from an allowable base claim.

Amended claim 10 requires a food blender with a substantially symmetrical body "curving outwardly from the lower end and then curving inwardly" between the upper and lower ends to enhance blending action in the jar. Santicola does not disclose a symmetrical body, as

required by claim 10. Therefore, claim 10 further distinguishes over Santicola so as to be in proper form for allowance.

Claims 11-14 depend from claim 10 and should be allowable as depending from an allowable base claim.

Amended independent claim 15 requires a food blender with a substantially symmetrical body having a cross sectional area changing "from small to largest to smallest to large". The Hartwig patent does not disclose the amended limitation. Hartwig only discloses a container having a cross sectional area progressing from large to small. Therefore, claim 15 distinguishes over Hartwig so as to be in proper form for allowance.

Claims 16-18 depend from claim 15 and should be allowable as depending from an allowable base claim.

Amended independent claim 19 requires a food blender with a substantially symmetrical body open only at the upper end. Claim 19 also requires that the body have "a generally circular cross sectional area between the upper and lower ends, the upper and lower ends having first and second diameters and the first intermediate portion having a diameter larger than either of the first or second diameters, and the second intermediate portion having a diameter smaller than either of the first or second diameters, the upper and lower ends being interconnected with the intermediate portion to define an outwardly and then an inwardly curved profile therebetween for enhancing the blending action within the jar".

Santicola does not anticipate claim 19, since Santicola is not substantially symmetrical and is not open only at the upper end, in view of spout 48. Therefore, claim 19 further distinguishes over the cited references so as to be in proper form for allowance. Claims 20-22 depend from claim 19 and should be allowable as depending from an allowable base claim.

Independent claim 23 requires a food blender having both enlarged and reduced cross sectional areas between the upper and lower ends. Hartwig does not have such a shape for a food blender jar. Accordingly, claim 23 distinguishes over the cited reference so as to be allowable. Claims 24-27 depend from claim 23 and should be allowable as depending from an allowable base claim.

### 35 U.S.C. § 103 Rejection

The Examiner asserts that Davidson in view of Hall teaches the invention of claims 1-27 by disclosing a general concept of reducing the cross section between larger curved cross sections, as illustrated by the decanters in Figures 7-9 in the Hall patent.

The Federal Circuit has explained, "under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so ... the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification above obvious unless the prior art suggested the desirability of the modification. (Emphasis added). In re Fritch, 23 U.S.P.Q. 1780, 1783-84 (Fed. Cir. 1992). More particularly, the Federal Circuit has stated that for a § 103 obviousness rejection based upon a combination of patents, there must be "some objective teaching" leading to the combination. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). As further explained by the Federal Circuit, in In re Denbiczak, 175 F.3d 994, 999 (Fed. Cir. 1999), the showing must be "clear and particular".

Here, the Hall patent provides no clear and particular suggestion or incentive to modify the Davidson blender jar to enhance blending. The shape of the Davidson jar tends to have cavitation problems, as discussed in the Background of the Invention. There is nothing in Hall to suggest that its decanter shape effects cavitation, since there is no cavitation problem caused by

food bridging in the wine bottle of Hall. Thus, there is no motivation to combine Davidson and Hall, such that claims 1-27 are allowable.

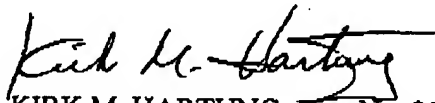
#### Conclusion

In view of the foregoing, Applicants respectfully request that a Notice of Allowance be issued.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

  
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